

REMARKS

Claims 1-10 are pending in the application. Claims 1-4 are the independent claims. The pending claims have been amended to better present the invention to the Office.

The Claims Are Directed To Patentable Subject Matter

The Office rejected claims 1-4 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because they are deemed to have no connection to the technological arts.

Although Applicant may not agree with the Office's interpretation and application of 35 U.S.C. § 101 in this instance, in order to expedite allowance Applicant nonetheless amends claims 1-4 to include the word "computer".

Accordingly, Applicant respectfully requests that the § 101 claim rejection be withdrawn.

The Claims Are Not Anticipated by Dedrick

The Office rejected claim 4 under 35 U.S.C. 102(b) as being anticipated by Dedrick (U.S. Patent No. 5,724,521). Applicant respectfully traverses this rejection, and submits that each pending claim is patentably distinguishable over the cited reference.

In order for a claim to be anticipated under 35 U.S.C. § 102, a single prior art reference must disclose, either expressly or inherently, each and every element as set forth in the claim. M.P.E.P. § 2131. Such anticipation does not occur in the instant application, however, because Dedrick fails to disclose each and every element as set forth in the pending claim for at least the following reason.

Independent claim 4 recites, in part, "receiving an advertisement request based on a bid generated by the agent." Since Dedrick contains no mention of, or reference to, an advertisement request based on a bid generated by an agent, it cannot anticipate claim 4 of the present application. The word "bid" does not even appear in Dedrick.

Accordingly, Applicant respectfully submits that independent claim 4, for at least the reason described above, is not anticipated by Dedrick under 35 U.S.C. § 102.

The Claims Patentably Define the Invention Over Dedrick

The Office rejected claims 1-3 under 35 U.S.C. § 103(a) as being unpatentable over Dedrick.¹ Applicant respectfully traverses this rejection, and submits that each pending claim is patentably distinguishable over the cited reference.

With respect to an obviousness rejection under 35 U.S.C. § 103(a), the Office bears the initial burden of establishing a *prima facie* case of obviousness. M.P.E.P. § 2142. To establish a *prima facie* case of obviousness, the Office must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. § 2143.

Applicant respectfully submits that Office has not established a *prima facie* case of obviousness for at least the following reasons.

Dedrick Does Not Teach or Suggest the Bid or Auction Claim Elements

Independent claim 1 recites, in part, “receiving a bid from one or more agents for selecting an advertisement for display.” Claim 1 further recites, in part, “holding an auction by a computer to determine a winning bid, wherein an advertisement associated with the winning bid is selected for display.” Since Dedrick contains no mention of, or reference to, receiving a bid or holding an auction, it cannot render obvious independent claim 1 of the present application. The words “bid” and “auction” do not even appear in Dedrick.

Accordingly, for at least these reasons, independent claim 1, along with its respective dependent claims (5-11), are not rendered obvious under 35 U.S.C. § 103(a).

¹ Applicant notes that the Office action appears to mistakenly cite to “Gerace” instead of “Dedrick” throughout portions of this rejection.

Independent claims 2 and 3 recite, in part, “wherein the agent is adapted to bid for selection of an advertisement.” Since Dedrick contains no mention of, or reference to, an agent adapted to bid for selection of an advertisement, it cannot render obvious independent claims 2 and 3 of the present application. As mentioned above, the word “bid” does not even appear in Dedrick.

Accordingly, for at least this reason, independent claims 2 and 3 are not rendered obvious under 35 U.S.C. § 103(a).

CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application is in clear condition for allowance. Issuance of a Notice of Allowance is earnestly solicited.


The Office is authorized to charge the three-month extension of time fee of \$1020.00 to Deposit Account No. 11-0600. A copy of this page is provided for this purpose.

Although not believed necessary, the Office is hereby authorized to charge any additional fees required under 37 C.F.R. § 1.16 or § 1.17 or credit any overpayments to Deposit Account No. 11-0600.

The Examiner is invited to contact the undersigned at 202-220-4200 to discuss any matter regarding this application.

Respectfully submitted,

Dated: January 7, 2005


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